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EXAMINER

CHAMBERS, MICHAEL S

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONATHAN R. ADAMS and ROBERT W. ADAMS

Appeal 2009-000594
Application 10/825,184
Technology Center 3700

Decided:¹ June 22, 2009

Before DONALD E. ADAMS, ERIC GRIMES, and FRANCISCO C.
PRATS, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This appeal under 35 U.S.C. § 134 involves claims 1, 2, 10, and 11, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a method of playing lacrosse. Claims 1, 2, 10, and 11 read as follows:

Claim 1: A method of playing lacrosse, wherein one or more lacrosse players is capable of intentionally adjusting the length of their lacrosse stick during a lacrosse game without leaving the lacrosse playing field.

Claim 2: A method of playing lacrosse, wherein one or more lacrosse players is capable of intentionally adjusting the length of their lacrosse stick without using any separate tools.

Claim 10: A method of playing lacrosse comprising:
using a lacrosse stick to play a lacrosse game on a lacrosse playing field, the lacrosse stick comprising a shaft and a head, the head being coupled to one end of the shaft and adapted to receive a lacrosse ball; and non-destructively adjusting the length of the shaft of the lacrosse stick one or more times during the game without leaving the lacrosse playing field.

Claim 11: A method of playing lacrosse comprising:
using a lacrosse stick to play a lacrosse game on a lacrosse playing field, the lacrosse stick comprising a shaft and a head, the head being coupled to one end of the shaft and adapted to receive a lacrosse ball; and non-destructively adjusting the length of the lacrosse stick one or more times during the game without using any separate tools.

The Examiner relies on the following evidence:

Dill et al.

US 5,935,026

Aug. 10, 1999

The rejections presented by the Examiner are as follows:

1. Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dill.
2. Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dill.

We affirm.

Anticipation:

PRINCIPLES OF LAW

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

On appeal to this Board, Appellants must show that the Examiner has not sustained the required burden. *See Ex parte Yamaguchi*, 88 USPQ2d 1606, 1608 and 1614 (BPAI 2008) (precedential); *Ex parte Fu*, 89 USPQ2d 1115, 1118 and 1123 (BPAI 2008) (precedential); *Ex parte Catan*, 83 USPQ2d 1569, 1570 and 1577 (BPAI 2007) (precedential); *Ex parte Smith*, 83 USPQ2d 1509, 1512-1514, 1519 (BPAI 2007) (precedential).

Because the hallmark of anticipation is prior invention, the prior art reference – in order to anticipate under 35 U.S.C. § 102 – must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements “arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed.Cir.1983).

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008).

Claim 1:

ISSUE

Have Appellants shown that the Examiner erred in finding that Dill teaches a method of playing lacrosse in which a player is capable of adjusting the length of a lacrosse stick during a game, without leaving the playing field?

FINDINGS OF FACT

FF 1. Dill teaches a lacrosse stick “having improved playability characteristics” (Dill, Abstract).

FF 2. More specifically, Dill teaches a lacrosse stick that provides the player with tactile stimuli which informs the player of the orientation of the head frame without the need for visual observation. “Thus, the player’s attention need not be diverted from the field of play or the ball in order to establish proper orientation of the head frame of the stick for reception of the ball” (Dill, col. 2, ll. 43-46).

FF 3. For clarity we reproduce Dill’s figure 4 below:

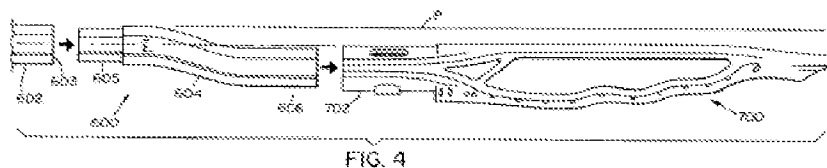


FIG. 4 is a diagrammatic partially exploded right side view of an embodiment of Dill’s invention (Dill, col. 3, ll. 44-46).

FF 4. Dill teaches a lacrosse stick, wherein the lacrosse player has the opportunity to include or omit element **604** from the lacrosse stick (Dill, col. 4, l. 65 - col. 5, l. 15).

ANALYSIS

Appellants contend that “Dill does not disclose adjusting the length of a lacrosse stick during a game and without leaving the playing field” (App. Br. 11). Instead, Appellants contend that “[a]ny lacrosse player would immediately know that the Dill concept is not to be performed on the playing field during a game” because Dill teaches that the lacrosse stick must be broken apart and a new shaft piece inserted between the shaft and the head (*id.*; *see also* Reply Br. 3). Appellants fail to identify, and we do not find, a teaching in Dill that the length of the lacrosse stick cannot be changed without leaving the playing field. Accordingly, we are not persuaded by Appellants’ contention to the contrary.

CONCLUSION OF LAW

Dill does not teach that the length of its lacrosse stick cannot be changed during a game, without leaving the playing field.

The rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Dill is affirmed.

Claim 2:

ISSUE

Have Appellants shown that the Examiner erred in finding that Dill teaches a method of playing lacrosse in which a player is capable of intentionally adjusting the length of a lacrosse stick without using any separate tools?

FINDINGS OF FACT

FF 5. Dill teaches that the “forward portion **604** [of the stick] is provided with fixation means **605**, such as a plug, whereby said forward portion **604** may be secured to the forward end **603** of the straight butt section **602**” (Dill, col. 5, ll. 2-5).

ANALYSIS

For the reasons set forth above, we find that Dill teaches a lacrosse stick whose length can be adjusted while playing lacrosse.

Appellants contend that Dill “requires the use of separate tools (*e.g.*, a screwdriver) to strongly affix the rear end via a fixation means 605” (App. Br. 12). We are not persuaded. Dill expressly states that the fixation means is a “plug” (FF 5). Accordingly, we are not persuaded by Appellants’ unsupported contention that “a person skilled in the art would know that a plug alone will not keep the lacrosse stick in one piece when playing lacrosse because the stick could fly apart into separate pieces during vigorous play. Instead, a screw or other fixation means is needed” (App. Br. 12).

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in finding that Dill teaches a method of playing lacrosse in which a player is capable of intentionally adjusting the length of a lacrosse stick without using any separate tools.

The rejection of claim 2 under 35 U.S.C. § 102(b) as being anticipated by Dill is affirmed.

Obviousness:

Claims 10 and 11:

ISSUE

Does Dill teach away from non-destructively adjusting the length of the shaft of a lacrosse stick while playing lacrosse?

PRINCIPLES OF LAW

“In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art.” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). On appeal to this Board, Appellants must show that the Examiner has not sustained the required burden. *See Ex parte Yamaguchi*, 88 USPQ2d 1606, 1608 and 1614 (BPAI 2008) (precedential); *Ex parte Fu*, 89 USPQ2d 1115, 1118 and 1123 (BPAI 2008) (precedential); *Ex parte Catan*, 83 USPQ2d 1569, 1570 and 1577 (BPAI 2007) (precedential); *Ex parte Smith*, 83 USPQ2d 1509, 1512-1514, 1519 (BPAI 2007) (precedential).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

Id. at 421. It is proper to “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. *See also id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). “In determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted).

ANALYSIS

For the reasons set forth above, we find that Dill teaches a lacrosse stick whose length can be adjusted while playing lacrosse. In addition, as discussed above, we find that Dill teaches the adjustment of the length of a lacrosse stick without the use of separate tools.

Appellants contend that Dill teaches a lacrosse stick that requires a destructive action (e.g., the breaking apart of the stick) to increase the length of the stick (App. Br. 13). According to Appellants, this action requires the stick to be inoperable during the adjustment period (App. Br. 14). We are not persuaded.

We recognize that claims 10 and 11 use the term non-destructively adjusting the length of the shaft of a lacrosse stick. We note, however, that Dill does not require the lacrosse stick to be destroyed in order to increase its length. Instead, Dill states that a lacrosse player has the opportunity to include or omit element **604** from the lacrosse stick (FF 3). In other words, the lacrosse stick may be lengthened through the use of element **604**, or shortened through the omission of element **604** as many times as the player

may desire during the course of a game. Therefore, while the inclusion or omission of element **604**, may require an intermediate step wherein elements **602** and **702** are not joined, the stick is not destroyed, instead it may be readily connected to have a longer length (thereby including element **604**) or a shorter length (thereby omitting element **604**). Accordingly, we find that Dill's modification to lengthen or shorten the length of a lacrosse stick is a non-destructive adjustment.

Further, while Dill's stick may be inoperable during the adjustment period, Appellants have failed to identify, and we do not find, a teaching in Dill that requires the player to leave the field during the adjustment period.

CONCLUSION OF LAW

Dill does not teach away from non-destructively adjusting the length of the shaft of a lacrosse stick while playing lacrosse.

The rejection of claims 10 and 11 under 35 U.S.C § 103(a) as unpatentable over Dill is affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

cdc
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